



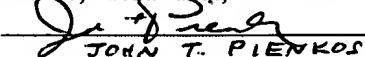
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of : John T. Pienkos
Serial No. : 09/694,402
Filing Date : October 22, 2000
For : SYSTEM AND METHOD FOR PROVIDING
REDUCED INSURANCE PREMIUMS
Confirmation No. : 9105
Group Art Unit : 3626
Examiner : Morgan, Robert W.

CERTIFICATION OF SUBMISSION

I hereby certify that, on the date shown below, this correspondence is being deposited with the United States Postal Service with sufficient postage by way of Express Mail in an envelope addressed to: Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: 5/26/09


JOHN T. PIENKOS

**Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

Dear Sirs:

APPEAL BRIEF UNDER 37 C.F.R. §41.37

This Appeal Brief is being filed pursuant to 37 C.F.R. §41.37 subsequent to the Applicant's filing of the Notice of Appeal on November 24, 2008. Accompanying this submission is the fee set forth under 37 C.F.R. §41.20(b)(2).

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I. REAL PARTY IN INTEREST

The real party in interest is Innovaport LLC, a Wisconsin limited liability company, which was formerly known as Patentbank L.L.C. The Applicant, John T. Pienkos, is the Chief Executive Officer of Innovaport LLC.

II. RELATED APPEALS AND INTERFERENCES

There are no prior pending related applications or patents that are under appeal, or the subject of an interference proceeding, or the subject of a judicial proceeding.

III. STATUS OF CLAIMS

Independent claim 26 is the sole pending claim of the present Application, is the only claim on appeal, and is shown in the Claims Appendix. All previously-pending claims of the present Application have been cancelled.

IV. STATUS OF AMENDMENTS

All amendments have been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The sole claim under appeal, independent claim 26, is for a method of providing insurance coverage to a customer. As discussed generally at page 6, line 27 through page 7, line 10 of the Specification, the method includes two sets of steps. The first set of steps (which generally correspond to FIG. 2A) are performed during a preliminary period of time and involve setting up an initial arrangement between an insurer and a prospective insured/insurance customer. By comparison, the second set of steps (which generally correspond to FIG. 2B) are performed during a subsequent period of time and involve setting up a further arrangement or “concluding arrangement” between the insurer and the prospective insured in which the prospective insured actually purchases a specific amount of insurance that provides a specific, limited amount of coverage.

First, during a preliminary period of time, the method includes (1) receiving an initial inquiry from the customer, (2) providing an input form including at least one field for an entry of a piece of information concerning at least one of a characteristic of the customer and a characteristic of an item to be insured, and (3) receiving the piece of information following its entry into the input form and submission. These steps find support in the Specification at, among other places, FIG. 2A and page 7, line 11 through page 9, line 3.

Additionally, during the preliminary period of time, the method also includes (4) performing processing in relation to the piece of information, (5) providing a preliminary indication to the customer that the customer will have an ability to order at least one of temporally-limited amounts of insurance and geographically-limited amounts of insurance, and (6) providing an identifier to the customer. These steps find support in the Specification at, among other places, FIG. 2A, page 9, line 3 through page 10, line 25, page 11, line 11 through page 12, line 31, and claim 2 (now cancelled) as originally filed with the present Application.

Next, at a subsequent period of time, the method further includes (1) providing a field for an input of a limitation relating to a desired insurance coverage regarding a customer-owned item, the limitation including a time period indication of a time period less than a month, (2) receiving the limitation at a central processor as provided by way of a customer-operated terminal, and (3) performing processing in relation to the limitation to determine whether the desired insurance coverage as restricted by the limitation can be provided. These steps find

support in the Specification at, among other places, FIG. 2B, page 14, line 4 through page 16, line 6 and claim 1 (now cancelled) as originally filed with the present Application.

Additionally, during the subsequent period of time, the method also includes (4) sending a confirmation to the customer-operated terminal concerning whether the desired insurance coverage corresponding to the limitation can be provided, (5) receiving a further signal from the customer-operated terminal indicating that the desired insurance coverage is still desired, and (6) concluding an arrangement so that the desired insurance coverage concerning the time period is provided to the customer. These steps find support in the Specification at, among other places, FIG. 2B and page 16, lines 6-16.

Further, during the subsequent period of time, the method also includes (7) receiving credit card information from the customer, wherein the central processor does not bill a customer credit card for the desired insurance coverage as restricted by the limitation until the central processor receives a confirmation from the customer-operated terminal via an internet-type connection that a newly-quoted price for the desired insurance is satisfactory, and (8) recording information regarding the desired insurance coverage as restricted by the limitation in an insurance company database. These steps find support in the Specification at, among other places, FIGS. 2A and 2B, page 13, lines 1-2 and 16-19, page 16, lines 6-14, and page 15, lines 27-31.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claim 26 is unpatentable under 35 U.S.C. 103(a) as being obvious over Luchs et al. (U.S. Patent No. 4,831,526), Felton (Felton, Bruce, "Rental Car Insurance: Staying out of financial potholes," The New York Times, March 23, 1997, pg. 3, 11), Cullen et al. (U.S. Patent No. 6,272,528), Underwood et al. (U.S. Patent No. 5,873,066) and Pescitelli et al. (U.S. Patent No. 5,845,256).

VII. ARGUMENT

Independent Claim 26

The Examiner rejected independent claim 26 under 35 U.S.C. 103(a) as being obvious in view of the combination of five (5) prior art references, namely, Luchs et al. (U.S. Patent No. 4,831,526), Felton (Felton, Bruce, “Rental Car Insurance: Staying out of financial potholes,” The New York Times, March 23, 1997, pg. 3, 11), Cullen et al. (U.S. Patent No. 6,272,528), Underwood et al. (U.S. Patent No. 5,873,066) and Pescitelli et al. (U.S. Patent No. 5,845,256).

As best as the Applicant can determine, the Examiner’s primary line of argument is that Luchs et al. shows the majority of the features recited in claim 26 insofar as it shows the use of a computer terminal to establish an insurance arrangement that, among other things, involves a time limit of less than a month. However, the Examiner appears to admit that Luchs et al. fails to show all of the recited features of claim 26, and particularly fails to show each of (i) that the time limit is a short-term time limit of less than a month (see page 4 of the Office action mailed on July 24, 2008), (ii) that the computer terminal being used to establish the insurance arrangement is a customer-operated terminal (see again page 4 of the Office action), (iii) the receiving of a further signal from a customer-operated terminal indicating that the desired insurance is still desired and the concluding of an arrangement so that the desired insurance coverage concerning the time period is provided to the customer (see page 5 of the Office action), and (iv) receiving credit card information from a customer (see page 6 of the Office action).

While admitting these deficiencies of Luchs et al., the Examiner proceeds to argue that items (i), (ii), (iii) and (iv) mentioned above are in fact disclosed respectively by Felton, Cullen et al., Underwood et al. and Pescitelli et al., respectively, and further that it would have been obvious to combine Luchs et al. with each of these references to arrive at the Applicant’s claimed invention. In this regard, the Examiner particularly argues that one of ordinary skill in the art would have been motivated to make these combinations to arrive at items (i), (ii), (iii) and (iv) because, respectively, one of ordinary skill in the art would have had the respective motivations of “allowing a customer to reduce the high cost of insurance” (page 4 of the Office action), “allowing a customer to receive the most suitable quotation for insurance over the

Internet” (page 5 of the Office action), “providing a system for quoting, binding and later issuing an insurance contract in which all relevant information pertaining to the risk is properly document and permanently stored” (page 5 of the Office action), and “allowing a customer to pay for insurance immediately” (page 6 of the Office action), respectively.

Notwithstanding these arguments advanced by the Examiner, the Applicant respectfully traverses the aforementioned obviousness rejection for several reasons. First, the Applicant disagrees with the Examiner’s contention in particular that it would have been obvious to one of ordinary skill in the art to combine Felton with Luchs et al. Second, in the Applicant’s view, the Examiner’s arguments have appeared to fail to address a significant aspect of the Applicant’s claimed invention and thus failed to explain how it would have been obvious to one of ordinary skill in the art to arrive at the Applicant’s claimed invention in view of the relied-upon references. Third and finally, in the Applicant’s view the Examiner has improperly used excessive hindsight reasoning to arrive at the conclusion that it would have been obvious to one of ordinary skill in the art to combine together disparate features from numerous (five) prior art references to arrive at the Applicant’s claimed invention.

In regards to the first issue relating to the motivation regarding item (i) of “allowing a customer to reduce the high cost of insurance”, while the Applicant admits that it is possible that an insurance policy having a term of less than one month might be less costly than an insurance policy having a term of longer length, the mere fact that rental car policy insurance is available for such short lengths of time does not necessarily mean that such short term insurance would be less costly for insuring a customer’s personally-owned vehicle (or other customer-owned item as recited in claim 26). Rather, in the Applicant’s view it is also plausible that the transaction costs associated with establishing insurance policies regarding customer-owned property could be sufficiently high that the purchasing of insurance having a term of less than a month might be considered excessively costly to pursue given the short-term extent of insurance coverage that would be obtained, and thus impractical to one of ordinary skill in the art. Thus, the Applicant does not agree that the mere fact that a rental car insurance article such as Felton might indicate the desirability of low-cost rental car insurance would cause one of ordinary skill in the art to arrive at the present invention involving short-term insurance for a customer’s own property.

Indeed, in the Applicant's view, the Applicant's particular method of operation recited in claim 26 is what might make it more cost-effective for a customer to pursue short-term insurance in relation to the customer's own property. The Applicant's claim 26 invention is directed toward a method by which insurance can be directly obtained from an insurance company by a customer, in relation to a customer-owned item, in a convenient simple manner that allows the customer to obtain short-term insurance on a repeated basis as needed. For example, the Applicant's claim 26 invention can allow the owner of an expensive sports car to obtain, on a repeated basis, short term insurance coverage pertaining to the owner's driving of such a sports car only during short time intervals (e.g., only on one weekend, once a month). To make this possible, the Applicant's claim 26 invention envisions that such a customer will first sign up to get general approval (establish an "initial arrangement") for obtaining short term insurance coverage (e.g., the features corresponding to part (a) of claim 26) and then later will obtain specific approval (establish a "concluding arrangement") with the insurer for specific insurance coverage during a specific short-term time period when an appropriate occasion for obtaining such insurance coverage arises (e.g., the features corresponding to part (b) of claim 26).

That said, the Applicant does not believe that the Examiner has demonstrated this particular two-part methodology as being disclosed or suggested by the five relied-upon prior art references. Indeed, as best as the Applicant can determine, the Examiner has not in the Office action addressed the fact that claim 26 includes not only a first set of steps encompassed by part (a) that occur specifically "during a preliminary period of time" but also a second set of steps encompassed by part (b) that occur specifically "at a subsequent period of time". In particular, the Examiner appears to be repeatedly relying upon the same passages in Luchs et al. both in arguing that the steps of part (a) are shown and that the steps of part (b) are shown (see, for example, the repeated reliance upon Fig. 10A-B, col. 22 line 5 to col. 23 line 28 for both steps (a)(2) and (b)(1), and the repeated reliance upon col. 2 line 55 to col. 3 line 5, col. 22 lines 5-35 and col. 28 lines 20-52 for both steps (a)(3) and (b)(2)). The Applicant simply cannot find within the Office action discussion by the Examiner contending that the references relied upon by the Examiner show two sets of steps performed at different times, or discussion as to why the same portions of Luchs et al. should be viewed as disclosing steps that occur at a preliminary period of time and also steps that occur at a subsequent period of time.

Finally, the Applicant respectfully submits that the combination of Luchs et al. with all of these many references for the aforementioned reasons merely represents an exercise of improper hindsight reasoning. While all of the five references relied upon by the Examiner admittedly relate to insurance in one form or another, in the Applicant's view at some point such analysis begs the question as to whether any novel concept whatsoever can be found nonobvious under 35 U.S.C. 103(a). As has been commonly put, there is nothing new under the sun, and new inventions are merely combinations of existing parts. Certainly it is the case that many inventions that have been found patentable have been found to be patentable even though all of the specific features of those inventions could be found in many prior art references if combined, and even though it was possible to offer plausible assertions as to why the disparate features might somehow have relevance to one another. Nevertheless, for an invention to be found nonobvious, at some point it must be recognized that the invention as a whole represented something that was sufficiently different from the prior art. In the Applicant's view, claim 26 of the present Application represents just such an invention.

In view of all of the above considerations, therefore, the Applicant respectfully submits that the Applicant's independent claim 26 is allowable under 35 U.S.C. 103(a) in view of any and all of the references relied upon by the Examiner, alone and/or in combination. The Applicant is submitting a request for a four-month extension of time and corresponding fee herewith given the time of submission of this Appeal Brief. If any additional time extension request (or any other request or provision) need be made to proceed with this appeal, please consider such request to have been provisionally made. Likewise, if any further fee needs to be paid for this appeal process to continue, please proceed with charging any such further fee to the credit card listed on the accompanying fee payment form.

Respectfully submitted,



John T. Pienkos
Applicant

Date: 5 / 26, 2009

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VIII. CLAIMS APPENDIX

The claim on appeal is:

26. (New) A method of providing insurance coverage to a customer, the method comprising:

(a) during a preliminary period of time:

- (1) receiving an initial inquiry from the customer;
- (2) providing an input form including at least one field for an entry of a piece of information concerning at least one of a characteristic of the customer and a characteristic of an item to be insured;
- (3) receiving the piece of information following its entry into the input form and submission;
- (4) performing processing in relation to the piece of information;
- (5) providing a preliminary indication to the customer that the customer will have an ability to order at least one of temporally-limited amounts of insurance and geographically-limited amounts of insurance; and
- (6) providing an identifier to the customer; and

(b) at a subsequent period of time:

- (1) providing a field for an input of a limitation relating to a desired insurance coverage regarding a customer-owned item, the limitation including a time period indication of a time period less than a month;
- (2) receiving the limitation at a central processor as provided by way of a customer-operated terminal;
- (3) performing processing in relation to the limitation to determine whether the desired insurance coverage as restricted by the limitation can be provided;
- (4) sending a confirmation to the customer-operated terminal concerning whether the desired insurance coverage corresponding to the limitation can be provided;
- (5) receiving a further signal from the customer-operated terminal

indicating that the desired insurance coverage is still desired;

(6) concluding an arrangement so that the desired insurance coverage concerning the time period is provided to the customer;

(7) receiving credit card information from the customer, wherein the central processor does not bill a customer credit card for the desired insurance coverage as restricted by the limitation until the central processor receives a confirmation from the customer-operated terminal via an internet-type connection that a newly-quoted price for the desired insurance is satisfactory; and

(8) recording information regarding the desired insurance coverage as restricted by the limitation in an insurance company database.

IX. EVIDENCE APPENDIX

None.

X. RELATED PROCEEDINGS APPENDIX

None.